

Appl. No.: 09/977,896
Amdt. Dated 12/28/2006
Reply to Office Action of 08/28/2006

REMARKS

This amendment is submitted with a request for a one month extension of time and appropriate fee in reply to the outstanding Office Action dated August 28, 2006. Claims 1-17 currently stand rejected. Applicants respectfully traverse these rejections and have added new claim 18 to further define patentable aspects of the invention. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections - 35 USC §102

Claims 12 and 14 currently stand rejected under 35 U.S.C. §102(e), as being anticipated by Hale (U.S. Patent No. 6,732,180, hereinafter “Hale”). Applicants respectfully traverse.

Independent claim 12 recites, *inter alia*, collecting one of a plurality of digital music files, which are substantially similar to an illegally produced digital music file, that has a greatest number of files having the same name, size and playing time. In other words, a single file is selected from among a plurality of files that are substantially similar to an illegally produced digital music file. The single file selected is the one among the plurality of files that has the most files having the same name, size and playing time. Independent claim 12 also recites, *inter alia*, modifying the collected digital music file. According to an embodiment of the present application, illegally produced digital music files may be sought out, collected, modified and redistributed into a network in the modified state.

Hale is directed to a method to inhibit the identification and retrieval of proprietary media. In this regard, Hale does not teach or suggest collection of proprietary media for modification and redistribution. To the contrary, Hale discloses the creation and distribution of decoy media which are not modified from a collected version of proprietary media, but which are instead newly created to have specific properties which may induce users to confuse the decoy media for the proprietary media they were seeking to acquire.

Appl. No.: 09/977,896
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In this regard, Hale discloses the storing and extraction of information about shared media (col. 6, lines 6-8). Specifically, Hale discloses that searches may be performed for proprietary media that falls within a protected class (col. 7, lines 39-40). The search results may be used to generate media templates used in the manufacture of decoy media (col. 7, lines 47-52). The decoy media, which may be shared through a network to dilute the network with decoy media, are constructed based on stored specifications included in the templates (col. 7, lines 61-64 and col. 8, lines 3-5). In other words, the decoy media are created or manufactured based on a template of information related to the proprietary media. The proprietary media is not collected and modified for redistribution. Accordingly, as an initial matter, Hale fails to teach or suggest collecting an illegally produced digital music file as recited in independent claim 12. To the contrary, Hale only discloses the collection of data regarding proprietary media and not collection of the media itself. Additionally, Hale fails to teach or suggest modifying the collected file as recited in independent claim 12. Instead, Hale discloses constructing the decoy media based on stored specifications having data regarding proprietary media. Indeed, as Hale only discloses the collection of data regarding proprietary media and not the collection of the proprietary media itself, Hale does not have possession of the proprietary media in such a way as to permit its modification. Thus, Hale fails to teach or suggest collecting an illegally produced digital music file and modifying the digital music file as recited in independent claim 12.

Hale also fails to disclose collecting one of the plurality of digital music files that has a greatest number of files having the same name, size and playing time. The Office Action appears to rely on the disclosure of Hale at col. 7, line 24 to col. 8, line 37 as disclosing this feature. However, the cited passage merely refers to a scanning process for defining a set of decoy media selections. Although the cited passage refers to an expansion process to account for misspellings and variations designed to avoid detection by automated means (col. 7, line 32-35), the expansion process fails to teach or suggest that one file having a greatest number of files having the same name, size and playing time is identified in any way, much less collected, as recited in independent claim 12. The remainder of the cited passage, and indeed all of Hale, similarly fails to provide any teaching or suggestion in this regard. Thus, Hale also fails to teach

Appl. No.: 09/977,896
Amdt. Dated 12/28/2006
Reply to Office Action of 08/28/2006

or suggest collecting one of a plurality of digital music files that has a greatest number of files having the same name, size and playing time as recited in independent claim 12.

Claim 14 depends directly from independent claim 12 and thus includes all the recitations of independent claim 12. Therefore, dependent claim 14 is patentable for at least those reasons given above for independent claim 12.

Accordingly, for at least the reasons stated above, Applicants respectfully submit that the rejections of claims 12 and 14 are overcome.

Claim Rejections - 35 USC §103

Claim 13 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hale in view of Fanning (U.S. Patent No. 6,366,907). Claims 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hale in view of Yoshiura (U.S. Patent No. 6,499,105). Claims 1-11 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hale in view of Fanning and Yoshiura.

Claims 1-11

Independent claims 1 and 7 recite, inter alia, collecting an illegally produced digital music file, encrypting (claim 1) or inserting a watermark (claim 7) into the collected file and redistributing the encrypted or watermarked file.

As stated above, Hale fails to teach or suggest any collection of an illegally produced digital music file. To the contrary, in Hale, specification data is gathered regarding proprietary files without actually collecting the files themselves. Hale therefore necessarily fails to teach or suggest modification by either encrypting or watermark insertion of a collected file, since no file is collected. However, even assuming for the sake of argument that Hale discloses collecting a file, as admitted in the Office Action, Hale still fails to teach or suggest modification by either encrypting or watermark insertion of a collected file. Furthermore, Hale fails to teach or suggest redistributing the modified (by encryption or watermark) file, since as stated above, Hale only discloses distribution of originally created decoy media and not redistribution of a collected and modified file. Accordingly, Hale fails to teach or suggest collecting an illegally produced digital

Appl. No.: 09/977,896
Amdt. Dated 12/28/2006
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music file, encrypting (claim 1) or inserting a watermark (claim 7) into the collected file and redistributing the encrypted or watermarked file as generally set forth in independent claims 1 and 7.

Fanning also fails to teach or suggest collecting an illegally produced digital music file, encrypting (claim 1) or inserting a watermark (claim 7) into the collected file and redistributing the encrypted or watermarked file as generally set forth in independent claims 1 and 7 and is not cited as such.

Yoshiura is cited as curing the deficiency of Hale with regard to encrypting and inserting a watermark. Yoshiura is directed to a digital authentication method which enables the encryption of information into purchased content so that if illegal copies of the purchased content are distributed, the source of the illegal copy (i.e., the purchaser of the corresponding purchased content) can be identified. As such, first and foremost Yoshiura fails to teach or suggest collecting an illegally produced digital music file, and is not cited as such. To the contrary, Yoshiura merely discloses an encryption/watermark scheme for insertion into a file when the file is purchased. Accordingly, there is no collection of an illegally produced digital music file. Furthermore, Yoshiura fails to teach or suggest any subsequent encryption or watermarking prior to redistribution of the file, since the encryption or watermarking of Yoshiura is an evolution that is performed prior to original distribution. Thus, Yoshiura also fails to teach or suggest collecting an illegally produced digital music file, encrypting (claim 1) or inserting a watermark (claim 7) into the collected file and redistributing the encrypted or watermarked file as generally set forth in independent claims 1 and 7.

Since none of the cited references alone teach or suggest collecting an illegally produced digital music file, encrypting (claim 1) or inserting a watermark (claim 7) into the collected file and redistributing the encrypted or watermarked file as generally set forth in independent claims 1 and 7, any combination of the cited references likewise fails to render independent claims 1 and 7 obvious for at least the same reasons described above. Claims 2-11 and 17 depend either directly or indirectly from a respective one of independent claims 1 and 7, and as such, include all the recitations of their respective independent claims. The dependent claims 2-11 and 17 are

Appl. No.: 09/977,896
Amdt. Dated 12/28/2006
Reply to Office Action of 08/28/2006

therefore patentably distinct from the cited references, individually or in combination, for at least the same reasons as given above for independent claims 1 and 7.

Claims 13, 15 and 16

As stated above, Hale fails to teach or suggest collecting one of a plurality of digital music files, which are substantially similar to an illegally produced digital music file, that has a greatest number of files having the same name, size and playing time and modifying the collected digital music file as recited in independent claim 12. Both Fanning and Yoshiura fail to cure the deficiency of Hale in this regard, and are not cited as such.

Claims 13, 15 and 16 each depend either directly or indirectly from independent claim 12, and as such, include all the recitations of independent claim 12. The dependent claims 13, 15 and 16 are therefore patentably distinct from the cited references, individually or in combination, for at least the same reasons as given above for independent claim 12.

Accordingly, for all the reasons above, Applicants respectfully submit that the rejections of claims 1-11, 13 and 15-17 are overcome.

Newly Added Claims

Applicant has added new claim 18 to more particularly define aspects of the present invention. The new claim includes no new matter and is fully supported by the specification and the drawings of the present application.

Accordingly, it is believed that the new claim is in condition for allowance.

Appl. No.: 09/977,896
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CONCLUSION

In view of the new claim and the remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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